

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/734,988 12/11/00 RESNICK

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TM01/0608

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PORTLAND OR 97204

EXAMINER

PWU, J

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

06/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/734,988

Applicant(s)

RESNICK ET AL.

Examiner

Jeffrey C Pwu

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

1. This action is responsive to the application, filed 2000-12-11.
2. The disposition of claims is: claims 35-55. Claims 35, 40, and 48 are independent.
3. The group art unit of the Examiner handling your case has changed. The new art unit is **2164**. *Please* use current art unit on all correspondence to help us route your case in a timely fashion.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 35-39, 48-50, and 54-55 are rejected under 35 U.S.C. 102(b) as being anticipated by *Sloan* et al. (WO 91/10976)

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Sloan et al. teaches a system for effecting electronic payments for goods or services comprising:

⇒ a terminal located at a point-of-sale (POS) where monetary consideration is received from or on behalf of an end-user to pre-pay for selected goods or services (200);

⇒ the terminal operable to exchange electronic messages with a financial network (100);

⇒ a financial network operable to exchange electronic messages with the POS merchants and further including a database associating a plurality of intermediary account number with corresponding end-user account numbers (400, 200, and page 7 line 5-page 9, line 16);

⇒ the payment processor operable to exchange electronic messages (page 6, line 5; page 9, line 10-16 and page 12, lines 14-21) with the terminal via the financial network and including means for crediting an indicia of monetary value to a corresponding intermediary account (dispensing station 200) in response to receiving a payment message from the POS terminal, and further including interface means for communicating at least a recharge transaction to a vendor to credit the associated end-

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user account in response to crediting the corresponding intermediary account (abstract, page 11, lines 18-36);

⇒ the POS terminal is an automated teller machine and/or a vending machine (page 11, lines 26-36);

⇒ the financial network comprises a card association network (fig. 1);and

⇒ an acquiring processor for communicating messages between the financial network and a plurality of terminals (page 2, lines 15-20 and page 17, lines 4-29).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 40-47 and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Sloan* (WO 91/10976) in view of *Klapka* (US 5,915,007).

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Sloan et al. teaches a method for effecting payment for various services substantially as claimed including:

⇒ establishing an intermediary account (200) having a corresponding account identifier (205);

⇒ associating the intermediary account (200) with an end-user's prepaid account (300) maintained by a vendor (page 11, lines 26-29);

⇒ conducting a transaction receiving a payment from the end-user at a POS together with the account identifier for loading value into the end-user's prepaid account (page 11, lines 26-29);

⇒ electronically communicating data indicative of the transaction from the POS to a central payment processor (100; fig.1);

⇒ validating the transaction data and transmitting a response to the POS (page 19, line 17-page 13, line 24);

⇒ if the validating step results in approval of the transaction, crediting a monetary value to the corresponding intermediary account, and sending a message the vendor for loading value into the end-user's associated prepaid account responsive to the payment transaction (page 19, line 17-page 13, line 24);

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⇒ the communication step comprises communication between POS and the central payment processor via a merchant hub (figs. 1-2 and page 19, line 17-page 13, line 24);

⇒ the collecting step is carried out in a batch mode on a daily basis (page 16, lines 28-30);and

⇒ the collecting step is effecting via the ACH (page 17, line 4-page 18, line 6).

However, *Sloan* fails to show the service provider being telecommunication vendor and having wireless services.

Klapka discloses a similar system (see col.3, lines 44-48, 55-56, 65-68; col. 5, lines 8-9, 24-60; col. 6, lines 50- 67; col. 7, lines 34-54) which provides a pre-paid vending machine for telecommunication services, including wireless communications (see col.7, lines 34-39; pin#2 is the intermediary account because it inherently has a number associated with it to identify that account)

It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to vend several different services, such as wired or wireless telecommunications, using the card system of *Sloan*, allow customers to make

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purchases at any time of the day or night in order to avoid service interruption (see page 2, lines 10-20 of Slaon et al.) and to provide customers a faster, portable, anytime, and anywhere telecommunication service.

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to

(703)-308-9051 (**formal** communications intended for entry)

Or:

(703)-305-9724 (**informal** communications labeled **PROPOSED** or **DRAFT**)

Hand-delivered responses should be brought to:

Sixth Floor Receptionist, Crystal Park II, 2121 Crystal Drive, Arlington, VA.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey PWU whose telephone number is (703) 308-7835 . The Examiner can normally be reached on Monday - Friday from 0800 to 1630 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Vinnie MILLIN, can be reached on (703) 305-9703.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1065.

Jeffrey Pwu

A handwritten signature in cursive script, appearing to read "Jeffrey Pwu".

May 26, 2001